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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,960	09/18/2003	Xiaoru Wang	82215ASMR	8319

7590 04/11/2006
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EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 04/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/665,960	Applicant(s) WANG ET AL.	
	Examiner Callie E. Shosho	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. All outstanding rejections are overcome by applicants' amendment filed 1/26/06.

The new grounds of rejection as set forth below are necessitated by applicants' amendment and thus, the following action is final.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 3-7, and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 has been amended to recite "wherein no monomer is present in the aqueous pigment mixture".

The cited phraseology clearly signifies a "negative" or "exclusionary" limitation for which the applicants have no support in the original disclosure. Negative limitations in a claim which do not appear in the specification as filed introduce new concepts and violate the description requirement of 35 USC 112, first paragraph, *Ex Parte Grasselli, Suresh, and Miller*, 231 USPQ 393, 394 (Bd. Pat. App. and Inter. 1983); 783 F. 2d 453.

The insertion of the above phraseology as described above positively excludes monomer from the aqueous pigment mixture, however, there is no support in the present specification for such exclusion.

As support for such amendment, applicants point to page 6 of the present specification. It is noted that page 6 discloses “under prior art method either no initiator is used or, where used, it is added to the colorant mixture with monomer and not, as in the present invention, initiator without monomer is added before adding the monomer mixture”.

However, this portion of the present specification refers to the initiator having no monomer not the aqueous pigment mixture. The “without monomer” appears to refer to the initiator and not the aqueous pigment mixture. That is, this portion of the specification discloses that the initiator alone, i.e. without monomer, is added to the aqueous color mixture. It does not disclose that the aqueous pigment mixture is without monomer. Thus, while this portion of the specification as originally filed provides support to recite that the initiator is without monomer, it does not provide support to recite that there is no monomer present in the aqueous pigment mixture.

NOTE: If applicants respond to the above 35 USC 112, first paragraph rejection of record by deleting the phrase “wherein no monomer is present in the aqueous pigment mixture”, the 35 USC 102(b) set forth in paragraph 4 of the office action mailed 8/24/05 and the 35 USC 103 rejection of record set forth in paragraph 8 of the office action mailed 8/24/05 would be reinstated against the present claims.

1.132 declaration

4. In the office action mailed 8/24/05, the examiner noted that the present claims recite “consisting essentially of” transitional language with respect to the aqueous colorant mixture, i.e. “consisting essentially of colorant particles, dispersant or surfactants, and water”. While Lin (U.S. 5,281,261) discloses that the aqueous colorant mixture contains monomer, on the one hand, the examiner noted that while it is recognized that the phrase “consisting essentially of” narrows the scope of the claims to the specified materials and those which do not materially affect the basic and novel characteristics of the claimed invention, absent a clear indication of what the basic and novel characteristics are, “consisting essentially of” is construed as equivalent to “comprising”. Further, the burden is on the applicant to show that the additional ingredients in the prior art, i.e. monomer, would in fact be excluded from the claims and that such ingredients would materially change the characteristics of the applicant’s invention, See MPEP 2111.03.

In order to meet such burden, applicants filed 1.132 declaration on 1/26/06. It is noted that in light of the amendment to present claim 1 to recite “wherein no monomer is present in the aqueous pigment mixture”, Lin is not applicable against the present claims and thus, the declaration is not necessary to overcome the rejections of record utilizing Lin. However, if applicants respond to the above 35 USC 112, first paragraph rejection of record by deleting the phrase “wherein no monomer is present in the aqueous pigment mixture” and the rejections of record utilizing Lin are re-instated against the present claims as described above, the 1.132 declaration would not be persuasive for the following reasons.

The declaration discloses preparation of composite colorant particles by mixing magenta pigment dispersion, monomer, and initiator and then adding water, monomer, and initiator. It

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was shown that the resulting composite colorant particles are only stable for 6 minutes which is in direct contrast to the present claims that require that the particles do not flocculate for up to 20 minutes.

However, it is the examiner's position that the declaration is not commensurate in scope with the prior art, Lin. It is noted that the "consisting essentially of" claim language set forth in the present claims is with respect to the aqueous pigment mixture while the prior art Lin discloses utilizing monomer in the aqueous pigment mixture. Given that the examiner previously argued that absent a clear indication of what the basic and novel characteristics are, "consisting essentially of" is construed as equivalent to "comprising", the burden was on applicant to show that the use of monomer in the aqueous pigment mixture is in fact outside the scope of the "consisting essentially of" transitional claim language. However, the declaration does not prepare composite colorant particles comprising monomer in the aqueous pigment mixture. Rather, the declaration adds monomer (and initiator) to an already prepared pigment dispersion. Thus, contrary to the "closest" prior art Lin, the monomer is not in the aqueous pigment mixture. It is not clear what, if any, difference this would have on the stability results.

Thus, given that the declaration did not include monomer in aqueous pigment mixture but rather added the monomer after the formulation of the aqueous pigment mixture, it is the examiner's position that the declaration has not shown (i) that the inclusion of monomer in the aqueous pigment mixture is excluded from the scope of the present claims that recite "consisting essentially of" claim language with respect to the aqueous pigment mixture and (ii) the use of monomer in the aqueous pigment dispersion would materially change the characteristics of the applicant's invention.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
4/7/06